

REMARKS:

The claims have been amended to emphasize the differences between applicant's invention and the cited prior art.

Specifically, applicant's invention relates to an oatstraw extract which is prepared by steeping oatstraw in heated water and filtering the steeped oatstraw to remove oatstraw particles. As discussed below, removal of the oatstraw particles allows the extract to be used as a topical lotion and as an additive in other products.

In some embodiments, the water used is magnetized or magnetically treated water. While both terms are understood to be equivalent by one of skill in the art, the instant claims have been amended to refer to "magnetically treated water" to emphasize that the magnetized water in applicant's invention is prepared by the process of magnetically treating water.

Claim 1 describes a topical lotion for relieving pain, swelling or inflammation which comprises glycerine; lavender oil; and oatstraw extract, wherein the oatstraw extract is prepared by steeping oatstraw in heated water and filtering the steeped oatstraw to remove oatstraw particles.

Claim 8 describes a method of treating pain, swelling, itching or inflammation wherein the above-described lotion is applied topically to inflamed, painful or swollen areas.

Claim 17 describes an additive comprised of at least 50% oatstraw extract, the oatstraw extract prepared by steeping oatstraw in heated water and filtering the steeped oatstraw to remove oatstraw particles, at least 25% glycerine, and 0.1-0.2% lavender oil and a suitable carrier.

Claim 18 describes a hair or body product comprising: at least 50% oatstraw extract, said oatstraw extract prepared by steeping oatstraw in heated water and filtering the steeped oatstraw to remove oatstraw particles, at least 25% glycerine, and 0.1-0.2% lavender oil and a suitable carrier.

Claim 20 describes a process for preparing an oatstraw extract comprising steeping a quantity of oatstraw in heated water, thereby producing an oatstraw mixture and then filtering the mixture to remove the oatstraw, thereby

producing an oatstraw extract.

Claim 25 describes a topical lotion for relieving pain, swelling or inflammation having an active ingredient consisting of oatstraw extract, the oatstraw extract prepared by steeping oatstraw in water and filtering the steeped oatstraw to remove the oatstraw, wherein the lotion is applied topically to the skin of an individual in need thereof.

Claim 26 is directed to an additive having an active ingredient consisting of oatstraw extract, the oatstraw extract prepared by steeping oatstraw in water and filtering the steeped oatstraw, wherein the additive is added to another product.

Claims 1, 2, 5-9, 17-22 and 24-30 were rejected under 35 USC 103(a) as being unpatentable over Weed in view of Puchalski and Jakobson.

Specifically, in the most recent office action, the examiner stated that Weed “teaches hot water extraction of oatstraw” and that “most of the active ingredients of oatstraw would have been extracted into water when ‘extracted with boiling water’”. The examiner has further stated that “using water extract only by filtering out the residues is an obvious alternative of keeping the residue in the water extract” and that “Weed does not teach against filtering. What Weed taught is a particularly situation, wherein the extract is made *in situ*”.

Applicant notes that using the USPTO’s definition of “extract”, which requires that something be removed from the starting material, it is impossible to have an extract that is in its original form (i.e. *in situ*). Furthermore, Weed does not teach an extract because nothing is removed from the solution. It is also noted that in the most relevant example, Weed states that the oats are not to be removed, as described below. Thus, Weed does not teach an extract, Weed teaches a suspension. Weed teaches against filtering and does not teach or suggest that filtering would be beneficial or that one could expect filtering to produce a successful product. This is in contrast with applicant’s invention, which is an oatstraw extract useful in a topical lotion or in other products.

On page 200, Weed describes the preparation of the infusion: “oatmeal made into a cake with water, baked and browned like coffee, then pulverized and

made into a coffee or infusion". Thus, Weed teaches preparing an infusion which may be strained to remove large particles. However, the preparation of the infusion bears no resemblance to applicant's method of preparing an oatstraw extract. Applicant notes that the infusion taught by Weed is a completely different product, prepared by a completely different process, which comprises preparing a baked oat cake which is then ground up like coffee.

On page 205, Weed teaches soaking feet in "strained oatstraw infusion" or soaking in a bathtub prepared by "boil[ing] water and pour[ing] over oatstraw in a large tub. When cooled sufficiently, bathe. (Yes, with the oats and all.)"

In the Response dated July 31, 2003, applicant argued that the rejection of Claims 1, 2, 5-9, 17-22 and 24-30 under 35 USC 103(a) as being unpatentable over Weed in view of Puchalski and Jakobson was improper in view of MPEP (2141) which states that:

*When applying 35 USC 103, the following tenets of patent law must be adhered to:*

- (A) the claimed invention must be considered as a whole;*
- (B) the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;*
- (C) the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and*
- (D) reasonable expectation of success is the standard with which obviousness is determined.*

It is further noted that MPEP 2141.02 states that "a prior art reference must be considered in its entirety, i.e. as a whole, including portions that would lead away from the claimed invention."

As noted in the afore-mentioned response, the examiner's statement on page 5 of the Office Action dated June 4, 2003 that "Weed provides no teaching or suggestion that the particular method disclosed therein is the only method to employ oatstraw. One of ordinary skill in the art would understand that oatstraw contains beneficial ingredients and would have been motivated to employ oatstraw in method

other than those expressly disclosed by Weed" is in conflict with MPEP 2141, particularly points (B) and (C). Specifically, the fact that Weed does not state emphatically that this is the only method does not and cannot mean that Weed therefore discloses all other methods of employing oatstraw, including those methods that Weed does not describe or suggest. That is, Weed does not teach or suggest filtering oatstraw; rather, the entire document is focused on uses of whole oatstraw. Thus, any teaching or suggestion of filtering or extracts is inconsistent with Weed as a whole.

Furthermore, the examiner appears to be admitting that Weed does not teach or suggest filtering an aqueous extract of oatstraw and using same as a topical lotion as described by applicant but is then concluding that this would have been obvious. The examiner however provided no sections in Weed nor any additional references supporting this position. Applicant is justifiably concerned that the examiner is considering Weed in hindsight in view of applicant's disclosure and is not considering Weed in its entirety as per MPEP 2141.

In the Advisory Action dated August 29, 2003, the examiner stated that "the removal of oatstraw is an obvious alternative (see the prior office action, page 5). Applicant's attention is noted to Weed, page 205, wherein other option without oatstraw reside is disclosed", referring to the oatstraw infusion.

It is noted that the non-relevance of the infusion was discussed in the response dated July 31, 2003. Furthermore, as noted above, the section on page 5 of the Office Action was believed to be contrary to MPEP 2141, as discussed above.

Applicant's representative therefore contacted the examiner by telephone to discuss these matters in an attempt to have the Final Action removed.

It is noted that in the telephone interview of October 6 with the undersigned, the examiner agreed that the oatstraw infusions and tinctures described by Weed were not relevant to applicant's invention because the oatstraw infusion was prepared by baking and browning an oatcake like coffee, then pulverizing the cake and making it into a coffee or infusion and the tincture was arranged to be ingested, not applied topically.

In this telephone interview however, the examiner stated that the statement "Boil water and pour over oatstraw in a large tub. When cooled sufficiently, bathe. (Yes, with the oats and all.)" (Weed, page 205) was not a "strong statement" and implied that it was not a necessary step to include the oats in the tub.

As discussed during the telephone interview, applicant does not agree with this position. Specifically, Weed states "yes, with the oats and all". There is nothing in that statement that implies that this is an optional step or that there is a choice involved. Furthermore, there is nothing in Weed which teaches or even implies filtering to remove the oatstraw residue from an aqueous extract.

Specifically, Weed states that the oats must be present. There is no statement that implies that filtering may be done. Furthermore, this would be inconsistent with the teachings of Weed as a whole which is focused on the benefits of whole oatstraw. Applicant simply cannot understand how this can be considered anything but a "strong statement" and that on this basis Weed teaches against filtering.

Furthermore, since the telephone interview, applicant's representative has carried out a search of the case law and appeal decisions for the term "strong statement" and has not been able to locate other usage of this term or a definition thereof. As such, it is unclear exactly what the examiner would consider to be a strong statement as there does not appear to be a definition for same.

Furthermore, even if this is held to not be a "strong statement", the fact remains that Weed does not teach, describe or suggest the desirability of filtering the aqueous oatstraw extract and that filtering and/or extracts go against the teachings of Weed when taken as a whole, as discussed above.

As noted above, under USC 103(a), the reference must not be considered in hindsight in view of applicant's disclosure. The examiner has not cited any sections within Weed or any other references which teach or suggest filtering oatstraw. As noted above, under USC 103(a), the entire reference must be considered, including those sections which teach against the claimed invention. As discussed in considerable detail herein, Weed does not teach or suggest filtering and

in fact teaches against filtering.

Thus Weed does not teach or suggest filtering an oatstraw suspension to remove the oatstraw particles. Furthermore, when considered as a whole, Weed clearly states that it is not desirable to remove the oatstraw. Thus, based on this, one of skill in the art would not expect that removing the oatstraw would produce a useful product. As noted above, based on the MPEP 2141, sections (B), (C) and (D), applicant believes that the invention as claimed overcomes the USC 103(a) rejection.

As noted previously, applicant discovered that the beneficial properties of the oatstraw are retained even in an oatstraw extract prepared by steeping the oatstraw in heated water and then removing the oatstraw. The extract can then be aliquoted for use as a topical lotion or can be added to other products, as discussed above. It is the step of filtering out the oatstraw that allows this to be done, which Weed teaches against. Specifically, adding dried oatstraw to bath water as taught by Weed leaves oatstraw which must be cleaned from the bath tub and which also adheres to the body of the individual and must in some cases be scrubbed off, thereby causing irritation to the skin which was to be treated. By removing the oatstraw, applicant has been able to produce an extract which can be applied to the skin or added to other products which would not be possible if the oatstraw extract was not filtered, as the oatstraw would leave an unpleasant residue or particles or clumps of oatstraw on the skin of the individual and the oatstraw would potentially interfere with other components within the other product. Applicant again notes that Weed teaches soaking in a bath containing oatstraw is necessary for benefits to be obtained. Weed does not teach preparing an oatstraw extract from which the oatstraw itself has been filtered out and applying this extract as a lotion to the skin topically (rather than soaking) or adding this extract to another product. Thus, applicant notes that there is a structural difference between applicant's filtered oatstraw extract and Weed's bathtub water with dried or pulverized oatstraw floating therein, in that applicant's invention has been filtered and Weed teaches against filtering, as discussed above. Furthermore, Weed's tub water with oatstraw in it could not be used for those purposes taught by applicant, that is, as a lotion or as an additive, as

discussed above, nor does Weed teach or even suggest that oatstraw would be suitable for these purposes. Specifically Weed teaches that the oatstraw must be present in the water and that the adhering of oatstraw residue to the individual's body is a "necessary evil" to obtain the benefits. Weed did not discover as did applicant that a filtered oatstraw extract would retain beneficial properties and that this extract could then be used as a lotion or as an additive to other products.

In summary, Weed does not teach an extract: Weed teaches a suspension which must contain the oats. Weed does not teach a filtered oatstraw extract which is used as a topical lotion or as an additive: Weed teaches bath water containing oatstraw. Weed does not teach or suggest filtering the oatstraw solution but rather teaches that the oatstraw must be left in the suspension in order for benefits to be obtained.

Applicant is respectfully concerned that the examiner is of the opinion that the instant invention is not patentable and is maintaining an objection which is not supported by the cited art. Specifically, applicant maintains that Weed is not a proper 35 USC 103(a) reference in view of the amended claims because as discussed above and in the previous response, Weed does not teach or suggest filtering an aqueous extract of oatstraw.

It is also noted that on at least two occasions (when arranging the telephone interview of October 6 and during the interview of October 6), the undersigned has requested that the examiner discuss this situation with the examiner's superior. Both times, this request has been rebuffed.

The examiner has also stated that "water as disclosed by Weed is considered to be equivalent to 'filtered and magnetized water'". The examiner has also stated that "the examiner has not been convinced that "magnetized water" and water would be any different for lacking of scientific evidence. The examiner fails to understand how the molecules of water, or their arrangement would be affected by magnet".

Applicant notes that when water passes through a magnetic field, the hydrogen ions and dissolved minerals in the water become charged. This charge

causes a temporary separation of these minerals and molecular water clusters resulting in water with increased clarity and softness, and reduced surface tension. In applicant's invention, this enhances the physical characteristics of the extract, such as conductivity, viscosity, softness and in turn facilitating ease of application, rate/depth of absorption and moisturization quality without leaving a film.

Applicant notes that the MPEP 2144 states that "the examiner must apply the law consistently to each application after considering the relevant facts. If the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court."

As discussed above, the claims have been modified to state that the water is magnetically treated water. Applicant notes that several references describing the benefits of magnetically treating water have previously been provided and also notes that there is considerable precedent at the USPTO regarding the patentability of magnetically treated fluids, such as US Patent 5,905,265 as well as devices for magnetically treating fluids, such as US Patent 5,500,121. Other patents relating to devices and methods for magnetically treating water or other fluids as well as patents which describe the utility of magnetically treated water include US Patent 6,250,118; US Patent 5,584,994; US Patent 6,171,490; US Patent 5,009,791; US Patent 4,946,560; US Patent 5,296,141; US Patent 5,500,121; US Patent 5,837,143; US Patent 5,866,010; US Patent 4,146,479; US Patent 4,299,700 and US Patent 4,422,933.

Regarding lack of support in the scientific literature, applicant notes that several articles have been provided previously, including "Magnetic treatment of water: possible mechanisms and conditions for applications", by V. Kochmarsky, *Magnetic and Electrical Separation* 7: 77-107, 1996. As discussed on page 102, this reference states that "magnetic treatment changes the rate of dissolution of CO<sub>2</sub> in water" and that this in turn promotes scale removal in water systems. As discussed on page 106, magnetic devices reduced scaling in over 60 percent of the cases tested in the former USSR and in 75-80% of the cases tested in the former East Germany and Czechoslovakia. Applicant notes that this dissolution of scaling is consistent with

applicant's proposed mechanism, discussed in an earlier response which is that when water passes through a magnetic field, the hydrogen ions and dissolved minerals in the water become charged. This charge causes a temporary separation of these minerals and molecular water clusters resulting in water with increased clarity and softness, and reduced surface tension. This in turn enhances the physical characteristics of the lotion, such as conductivity, viscosity, softness and in turn facilitating ease of application, rate/depth of absorption and moisturization quality without leaving a film. Johnson et al., 1998, *Journal of Clinical Periodontology* 25: 316-321 describes how a magnetized water oral irrigator significantly reduced calculus formation, which the authors state is consistent with the theory of hydromagnetics, that is, that magnetized water prevents or inhibits mineralization (page 319). Thus, applicant notes that the effects of magnetization on water or magnetically treated water are documented, as discussed above.

Thus, there is precedent at the Patent Office for allowing claims including magnetically treated fluids as limitations within the claims and also for devices for magnetically treating fluids such as water, clearly indicating that the Patent Office has previously recognized that magnetically treated water has unique and different properties. On this basis, it is believed that the claims including magnetically treated water should be approved.

It is noted that MPEP 716.02 (b) states that "evidence of unexpected properties may be in the form of a direct or indirect comparison of the claimed invention with the closest prior art which is commensurate in scope with the claims".

The previous examiner stated that the affidavits of the inventor and Rick Green submitted previously were not relevant because they were "directed at a distinction between deionized water and 'magnetized' water". Applicant notes that regular tap water is not used in cosmetic or pharmaceutical preparations and that deionized water is used, meaning that in this instance, the use of deionized water represents the closest art when considering the extract used as a topical lotion or additive. It is also noted that on one hand the examiner is taking the position that magnetically treated water is equivalent to tap water but on the other hand that tap

water is not equivalent to deionized water. It is further noted that as discussed above the literature contains support for differences between magnetized water and other types of water, for example, deionized water. It is of note that differences in conductivity and pH were noticed between deionized and magnetically treated water as discussed in Mr. Green's affidavit. The affidavits also describe the differences observed when applicant's invention was prepared with deionized water instead of magnetically treated water.

Furthermore, as discussed in Mr. Green's affidavit, he was initially in agreement with the examiner and believed that substituting deionized water for magnetically treated water would have no effect on the product. However, as discussed in the affidavit submitted previously, he was surprised when the use of magnetized water resulted in a lotion having improved absorption characteristics compared to the lotion prepared with deionized water. As can be seen from Mr. Green's curriculum vitae, he clearly qualifies as an expert in this area (see United States v. Adams et al., 383 US 39; 86 S. Ct. 708; 15 L. Ed. 2d 572; 1966). As such, applicant believes that this affidavit clearly indicates that magnetically treated water has different properties compared to non-magnetized water, be it tap water or deionized water.

It is also noted that the MPEP 716.01 (C) states that "some weight ought to be given to a persuasively supported statement of one skilled in the art on what was not obvious to him". It is further noted that in this instance, the expert has no interest in the outcome of this case.

Thus, as discussed above, applicant has provided scientific articles which describe the properties of magnetically treated water. There is also precedent at the USPTO for allowing claims describing magnetically treated fluids and also for devices for magnetically treating fluids. It is also noted that as discussed above, the use of magnetically treated water in applicant's oatstraw extract produces a lotion which has improved absorption among other properties as discussed in the previously submitted affidavits.

It is noted that the inventor is at a critical stage in the commercialization of this invention. A licensee is pursuing commercialization opportunities and clinical trials are being planned. However, these activities may be discontinued if applicant is forced to file an appeal. That is, the time and uncertainty regarding the appeal process will likely result in the commercialization of applicant's invention suffering irreparable damage.

In summary, it is respectfully requested that the examiner reconsider his position and remove the final action. It is noted that as discussed above and previously, the Weed reference is not a proper 35 USC 103(a) reference in view of the prior amendments to the claims and the arguments forwarded above. Furthermore, the examiner appears to be applying hindsight and the teachings of applicant's disclosure to the Weed reference and as a consequence inferring disclosure that is simply not present in Weed. It is further noted that the examiner has maintained that filtering an aqueous extract of oatstraw is obvious in view of prior art dealing with extracts of herbs and such but has not provided any references which specifically teach a filtered aqueous extract of oatstraw. It is further maintained that the Weed reference does not teach or suggest filtering an aqueous extract of oatstraw and in fact teaches against filtering, as discussed above. The examiner's reason for rejection, that either Weed "does not teach that the particular method disclosed is the only method "or in the contrary that Weed's statement to include the whole oats is not a "strong statement" are simply not understood. Specifically, as discussed above, Weed says "yes, oats and all". The fact that Weed does not specifically say that this is the only way to do it does not change the fact that Weed does not teach or suggest filtering.

In view of the foregoing, further and more favorable consideration is respectfully requested.

Respectfully submitted

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